

REMARKS

The above referenced patent application has been reviewed in light of the Office Action, dated September 18, 2008, in which:

- the Assignee is required, under 35 U.S.C. § 121, to provisionally elect a single disclosed species for prosecution on the merits.

The PTO has asserted that the following are distinct species of the claimed invention:

- Species I: (Claim 1-32)
An integrated decision feedback equalizer and clock and data recovery circuit, classified in class 375, subclass 233.
- Species II: (Claims 33-47)
An integrated retimer and phase detector classified in class 375, subclass 373.
- No claims are generic to all species.

Reconsideration of the above referenced patent application in view of the following remarks is respectfully requested.

Claims 1-32 are now pending the above referenced patent application. Claims 33-47 have been provisionally withdrawn. No claims have been cancelled, amended, or added. No new matter has been entered.

1. 35 U.S.C. § 121

M.P.E.P. § 803 sets forth both the standard of a *prima facie* case of § 121 restriction and the burden of proof for making the *prima facie* case.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

GUIDELINES

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases.

Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.

If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should not be required. In re Lee, 199 USPQ 108 (Comm'r Pat. 1978).

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02

Although the Assignee traverses the restriction and does not believe the restriction requirement is proper, nonetheless, Assignee provisionally elects to prosecute species I, claims 1-32.

The non-elected claims, Claims 33-47, have been withdrawn; however, Assignee intends to pursue the cancelled claims to issuance in a separate divisional patent application (to be filed). Therefore, no prosecution history estoppel or change in scope of the claims should result from the foregoing cancellations.

M.P.E.P. § 808.1 sets forth both the standard of the first prong (the independent test) of a *prima facie* case of § 121 restriction and the burden of proof for meeting the first prong.

§ 808.01 Reasons for Holding of Independence or Distinctness

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

For example, relative to a combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the subcombination as claimed.

Assignee submits that the inventions are related because they are disclosed as capable of use together. Claims 1-32 recite integrated decision feedback equalizer and clock and data recovery circuits and a method of using embodiments thereof. Claims 33-47 recite an integrated retimer and phase detector and a method of using embodiments thereof. The PTO's assessment that "Group I is related to a transmitter and Group II is related to a receiver" (Sept 2008 Office Action, page 2) is not stipulated to or agreed upon. Although, it is understood that the above are merely a few illustrative examples to which the disclosed subject matter is not limited.

The specification discloses that the inventions are capable of use together. For example, at least in paragraph [0038] (emphasis added):

In the embodiment of FIG. 4, the clock recovery circuit 420 includes a phase detector 414, a charge pump 416, a loop filter 418 and a voltage controlled oscillator ("VCO") 422. The extracted clock 412 generated by the VCO is fed back to the phase detector 414. The phase detector 414 compares the transition edge of the data signal (D) with an edge of the extracted clock and generates a corresponding phase error signal that is sent to the charge pump 416.

At least in this example, the disclosed system may be used to perform the recited methods. Assignee's respectfully asserts that the clock recovery circuit claimed in Group I, Claim 1-32 may, in various embodiments, include the phase detector in Group II, Claims 33-47. See also, for example, Fig. 4 which illustrates the clock recovery circuit including a phase detector. It is respectfully asserted that the Groups I & II are not transmitter and receiver, as the PTO claims, but both aspects of a receiver. Although, it is understood that the above are merely a few illustrative examples to which the disclosed subject matter is not limited.

Thus, the inventions are disclosed as capable of use together and, therefore, are related.

Furthermore, Assignee submits that a search and examination of all the claims can be made without serious burden (the second prong of *prima facie* case of § 121 restriction). Assignee submits that a proper search for all of the claims would potentially include all of the classes and subclasses listed for the groups. Thus, a serious burden would not result since all of the classifications would potentially be searched for each of the groups.

For at least these reasons, Assignee respectfully requests reconsideration and withdrawal of the restriction requirement or, alternatively, reconsideration and modification of Groups II-IV to a single group.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all claims pending in this application, as amended, are in condition for allowance. If the Examiner has any questions, they are invited to contact the undersigned at 202-470-6450. Reconsideration of this patent application and early allowance of all claims is respectfully requested.

Respectfully submitted,

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Dated

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